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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,875	01/12/2001	Jerome L. Krupa	P1329USA	2537

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PATENT DOCKET DEPARTMENT  
GARDNER CARTON & DOUGLAS LLC  
191 N. WACKER DRIVE, SUITE 3700  
CHICAGO, IL 60606

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 05/12/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/759,875

Applicant(s)

KRUPA, JEROME L

Examiner

Mark T Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-90 (51-93, renumbered 48-90) is/are pending in the application.
- 4a) Of the above claim(s) 15-64 and 76-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 3722

## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Continued Examination Under 37 CFR 1.114***

1. Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission, filed on March 27, 2003. However, newly submitted claims 15-64 and 76-93 are directed to an invention that is independent or distinct from the invention elected in Paper No. 5 for the following reasons: Claims 51-64 are now directed to a container assembly which is classified in Class 206,

Art Unit: 3722

Subclass 96; Claims 76-93 are now directed to a method of filling a prescription which is classified in Class 235, Subclass 462.32.

Since applicant has received an action on the merits for the claimed invention elected in Paper No. 5, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 51-64 and 76-93 are withdrawn from consideration as being directed to a non-elected invention, since applicant may not switch inventions as a matter of right or add new matter in RCE applications. See 37 CFR 1.114 and MPEP § 706.07(h).

***Election/Restriction***

2. This application contains claims 15-47 which are drawn to an invention non-elected without traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Art Unit: 3722

canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 51-93 have been renumbered as claims 48-90.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 65, 66, 68-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidl (6,447,014).

Seidl discloses in Fig. 2B, 3 and 4, a label used for pharmaceutical use, wherein a symbol (52) is printed on a second label (2) and can be initially placed on an object (such as a container); a transparent label (1) comprising indicium (51); wherein the indicium is adjacent, and aligned with the symbol (as seen in Fig. 3) so as to allow the indicium and the symbol to be scanned together by a detector (code reader, Col. 2, lines 43-45); and wherein the label (1) has a portion

Art Unit: 3722

(left side of indicium in Fig. 2B) which may cover part of the symbol (52) while allowing for simultaneous scanning by a detector.

However, Seidl does not disclose: a label having a first portion having an outer boundary, and a second portion extending out and away from a side and corner of the outer boundary of the first portion; indicium on the second portion identifying pharmaceutical information prescribed to a patient, wherein the indicium is a checksum of the symbol, and the checksum includes a check digit of the checksum; and wherein the first portion and second portion are generally rectangular in shape.

De La Huerga discloses in Fig. 16 and 17, a label (50) having a rectangular first portion (527) with indicia (52) and with an outer boundary (527a), and a second portion (529) extending out and away from the outer boundary of the first portion and having indicium (Col. 9, Par. 0111).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Seidl's label to include a first portion and an extended second portion as taught by De La Huerga for the purpose of providing indicia to be easily recognizable and distinct from the main label portion.

In regards to **Claims 65**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making,

Art Unit: 3722

the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, the symbol and label indicia can be programmed to be used to determine any result desired by the end user.

In regards to **Claims 65, 72, 74 and 75**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desirable indicia on the label, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, De La Huerger's label is capable of having checksum and check digit indicia for pharmaceutical purposes.

In regards to **Claim 69**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to extend the second portion at any desirable location from the first portion, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In regards to **Claim 68**, it would have been an obvious matter of design choice to make the second portion of whatever form or shape was desired or expedient. A change in form or

Art Unit: 3722

shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

In regards to **Claims 7-8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desired substance in the container, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siedl in view of De La Huerga and further in view of Clark et al (4,641,347).

Seidl as modified by De la Huerga discloses a label comprising all the elements as claimed in Claim 65, and as set forth above.

However, Seidl and De la Huerga do not disclose wherein the symbol is printed on the container.

Clark et al discloses in Fig. 4d, a package (22) having a printed symbol on the package (Col. 3, lines 9-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Seidl's label to include a printed symbol on a container as taught by Clark et al for the purpose of providing an alternative way of labeling a container.



Art Unit: 3722

***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Bernier et al, Nelson, Ooshima et al, Blanford et al, Luttrell, Seidl, Clark et al, Peoples, Jr., Wilson, Mase et al, Ackley et al, and Peoples, Jr. ('761) disclose similar inventions.

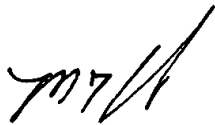
***Response to Arguments***

6. Applicant's arguments with respect to claims 15-93 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3722


**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

May 2, 2003



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